

REMARKS

As discussed herein, Applicants respectfully request reconsideration and withdrawal of the rejection of record.

Preliminary Matters

Applicants respectfully request acknowledgement of Applicants' claim of priority based on Appln. No 60/215,237 in the next communication from the Patent Office.

Applicants further request a signed and initialed copy of the Form PTO-FB-820, filed with Applicants' Supplemental Information Disclosure Statement on 6 Nov 2003, to indicate the Examiner's consideration of the cited information.

Status of the Claims

Claims 2-10 are pending and remain rejected based upon applied art. Claim 3 is amended herein to depend from claim 2.

Response to Obviousness Rejection

Claims 2-10 are finally rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 00/26244 ("KANEKO") in view of U.S. Patent No. 5,747,467 to Agouridas et al. ("AGOURIDAS"). The rejection finds Applicants' arguments unpersuasive and continues to rely on the grounds for rejection set forth in the 2 May 2003 Office Action. That rejection asserted that the only difference between KANEKO and the claimed invention is that KANEKO does not disclose a halogen at the 2-position, which was said to be known in the art. The rejection thus stated that the skilled artisan would have been motivated to modify KANEKO according to AGOURIDAS allegedly because the skilled artisan allegedly would have expected the resulting compounds to be useful as antibiotics.

Applicants respectfully submit that the rejection is improper because KANEKO is not available as prior art, *inter alia*, in an obviousness rejection.

First, Applicants respectfully submit that KANEKO is not prior art under 35 USC § 102(a). KANEKO has a publication date of 11 May 2000. However, the present invention was reduced to practice before 11 May 2000, as evidenced by the Rule 131 Declaration of inventor Takushi Kaneko, Ph.D, submitted herewith. See MPEP 715.02. Dr. Kaneko's Declaration states that the present invention was completed before 11 May 2000. As evidence, Dr. Kaneko includes Exhibit A, which is a copy of an invention disclosure that was prepared before 11 May 2000 and which details the conception and actual reduction to practice of embodiments of the claimed invention.

As to §§ 102(e, f, and g), US 2003/0013665 to Kaneko ("665") is a family member of KANEKO, which is pending as Appln. No. 10/206,652. However, the subject matter of '665 and the presently claimed invention were commonly assigned or subject to an obligation to assign to a common assignee at the time of the presently claimed invention. Thus, even assuming that KANEKO or '665 were prior art, under 35 U.S.C. § 103(c), the subject matter thereof cannot be applied in an obviousness rejection against the present claims.

As to § 102(b), KANEKO was published less than one year before Applicants' earliest filing date of 30 June 2000. Thus, KANEKO is not § 102(b) art in this case.

For at least these reasons, Applicants' respectfully submit that the rejection is improper and that, although not acquiescing in the rejection, direct treatment on the merits should not be required.

Applicants therefore respectfully request reconsideration and withdrawal of the rejection.


Conclusion

In view of the above, Applicants respectfully submit that all of the pending claims are allowable in their present form, and that the application is otherwise in condition for allowance. The Examiner is respectfully requested to withdraw the rejections and, as the next official action, to provide a Notice of Allowance.

If any issues remain which can be resolved by a telephone conference, or should the Examiner have any questions or comments regarding this matter, the Examiner is respectfully invited to contact the undersigned at the telephone number shown below.

Respectfully submitted,

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